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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,669	12/31/2003	Donald C. Wood	CLEV:629	2780
27890	7590	05/05/2006	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER

3711

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,669	Applicant(s) WOOD ET AL. C	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 6-26 is/are pending in the application.
 4a) Of the above claim(s) 2 and 7-9 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 6 and 10-26 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 10-16 and 20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 20 refer to a figure 4 and it is not necessary (See article 2173.05(s) MPEP). In claims 6 and 20 it is not certain what the limits of the claim are. Claims 10-16 are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima in view of Llwellyn or Wohldorf.

Nakajima (Figs. 1-2) disclose a club having a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, and club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Nakajima lacks a fitting system kit with data to fit a length of a club to a player. Llewellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Nakajima to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This clubs are able to perform the claimed function.

5. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novosel in view of Llewellyn or Wohldorf.

Novosel (Figs. 1, 4) disclose a club having a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, and club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Novosel lacks a fitting system kit with data to fit a length of a club to a player. Llwellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Novosel to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This clubs are able to perform the claimed function.

6. Claims 6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Llwellyn or Wohldorf.

Flood discloses a club having a spherical ball with a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft (Fig. 4), a club having a length of about 37 $\frac{1}{4}$ and 37 $\frac{1}{2}$ inches in the form of shaft portion (36) being about 34 inches and the terminal portion (40) being about 2 to about 5 inches (Fig. 4, Col. 2, Lns. 58-67), a kit in the form of the parts being separated (Fig. 5) and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Flood lacks a fitting system kit with data to fit a length of a club to a player. Llwellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050],

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Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Flood to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

7. Claims 6 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llwellyn or Wohldorf.

Yim disclose a club having a spherical ball with a hosel bore therein (Fig. 1), a shaft in a hosel bore, a grip at the end of a shaft (Fig. 3), an exterior surface of a spherical ball comprising a flat surface parallel to an axis of a hosel bore (Abstract, Fig. 1), a kit in the form of the parts being separated (Figs. 1 and 3) and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Yim lacks a fitting system kit with data to fit a length of a club to a player. Llwellyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Yim to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

8. Claims 6, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witherspoon in view of Llwelllyn or Wohldorf.

Witherspoon discloses a club having a spherical ball having a hosel bore therein with the hosel portion extending (17) radially from a ball and the hosel bore being in the extending hosel portion (Fig. 2), a shaft in a hosel bore (Fig. 2), a grip at the end of a shaft (Fig. 1), and a club able to perform the function of fitting a desired length for an iron to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Witherspoon lacks a fitting system kit with data to fit a length of a club to a player. Llwelllyn discloses data to fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). Wohldorf discloses data to fit a club length to a player ([0050], Chart 4). In view of the publications of Llewellyn or Wohldorf it would have been obvious to modify the club of Witherspoon to have a fitting system kit with data to fit a length of a club to a player in order to custom fit a club to a golfer.

In an apparatus claim weight is give to what an apparatus is and not how it is used or made. This club is able to perform the claimed function.

9. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llwelllyn or Wohldorf as applied to claims 6 and 12-13 above, and further in view of Witherspoon.

Yim lacks a hosel portion extending substantially radially from a spherical ball. Witherspoon discloses a club having a spherical ball having a hosel bore therein with the hosel portion extending (17) radially from a ball and the hosel bore being in the extending hosel portion (Fig. 2). In view of the patent of Witherspoon it would have been obvious to modify the club of Yim to have a hosel portion extending substantially radially from a spherical ball in order to provide more support to the tip end of the shaft where it is connected to the head.

10. Claims 17, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novosel in view of Llwelllyn.

Novosel (Figs. 1, 4) disclose a club having a spherical ball having a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft, and club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Novosel lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llwelllyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer

(Abstract). In view of the publication of Llewellyn it would have been obvious to modify the club of Novosel to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

11. Claims 17-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flood in view of Llewellyn.

Flood discloses a club having a spherical ball with a hosel bore therein, a shaft in a hosel bore, a grip at the end of a shaft (Fig. 4), a club having a length of about 37 ¼ and 37 ½ inches in the form of shaft portion (36) being about 34 inches and the terminal portion (40) being about 2 to about 5 inches (Fig. 4, Col. 2, Lns. 58-67), a kit in the form of the parts being separated (Fig. 5) and a club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Flood lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llewellyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). In view of the publication of Llewellyn it would have been obvious to modify the club of Flood to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

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12. Claims 17, 20, 21, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llwelllyn.

Yim disclose a club having a spherical ball with a hosel bore therein (Fig. 1), a shaft in a hosel bore, a grip at the end of a shaft (Fig. 3), an exterior surface of a spherical ball comprising a flat surface parallel to an axis of a hosel bore (Abstract, Fig. 1), a kit in the form of the parts being separated (Figs. 1 and 3) and a club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Yim lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llwelllyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). In view of the publication of Llwelllyn it would have been obvious to modify the club of Yim to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

13. Claims 17, 20, 22-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witherspoon in view of Llwelllyn.

Witherspoon discloses a club having a spherical ball having a hosel bore therein with the hosel portion extending (17) radially from a ball and the hosel bore being in the extending hosel portion (Fig. 2), a shaft in a hosel bore (Fig. 2), a grip at the end of a

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shaft (Fig. 1), and a club able to perform the function of fitting a desired length for a club to an individual player in the form of one skilled in the art able to observe how this club with its length fits to a player and giving appropriate recommendations to a player.

Witherspoon lacks a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims to fit a length of a club to a player. Llewellyn discloses a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims fit a club length to a player (Fig. 4) in order to custom fit a club to a golfer (Abstract). In view of the publication of Llewellyn it would have been obvious to modify the club of Witherspoon to have a fitting system kit with data having LCC, WFM, and PH value ranges as defined by the claims in order to custom fit a club to a golfer.

14. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yim in view of Llewellyn as applied to claims 17, 20, 21, and 25-26 above, and further in view of Witherspoon.

See paragraphs above for elements of structure previously rejected by Yim in view of Witherspoon.

Response to Arguments

15. The argument that it there is no practical way to define Applicant's claimed invention in words without incorporating by reference in claims 6 and 20 the fitting data of figure 4 is disagreed with. The claims claim the data of figure 4. It mentions no form

or structure in which the data is contained. It could be in one's head. The examiner is uncertain if this data is required to be shown in any readable way. This claimed element of data is not tangible or even limited to that which is used consistent with an apparatus of a kit. The examiner is not certain as to the limit and bounds of this claimed feature of the data in figure 4. The argument that it is improper to combine the references of Nakajima and Llewellyn due to the data of figure 4 not being presented is disagreed with. As mentioned above there is no limit as to how the data is presented. For an apparatus claim of a kit with a fitting ball club and data of figure 4, just a fitting ball club would read on the claim in that there is not structure required for the data of figure 4. It could be in someone's head. Even so if it was in a tangible form as being written the courts have found that instructions were not functionally related to a kit. The court concluded that the printed matter didn't depend on the kit and the kit didn't depend on the printed matter (In re Ngai (5/13/04) (Michel, Gajarsa, Linn) (per curiam)). The examiner sees the data of figure 4 as being instructions. The references of Llewellyn or Wohldorf clearly disclose that it is known to have data/instructions to fit a length of a club to a player. Clearly the ball club of Nakajima has a lie and a club length (Fig. 2) and would be in need to be fitted to a specific player based on the characteristics of the player. Llewellyn or Wohldorf show that it is known to have data to do such. The argument that it is improper to use the references of Llewellyn or Wohldorf since these are based on empirical results with conventional clubs is disagreed with. Clearly referred to charts/tables in these references with respect to length are independent of any experiments and use only the dimensions of the player (See Chart 4 for Wohldorf

and figure 4 for Llewellyn). It would be very obvious to one skilled in the art to use only a shaft length fitting instructions/data for a kit to fit a club length to a player since Nakajima has a rounded sole for a head and Nakajima needs a club length. The same arguments would apply to Novosel or Flood or Yim or Witherspoon in view of Llewellyn or Wohldorf. Novosel (Fig. 7) or Flood (Fig. 4) or Yim (Fig. 3) or Witherspoon (Fig. 5) will each have a lie and club length and are in need to fit a length to a specific player. It would be very obvious to one skilled in the art to use only a shaft length fitting instructions/data for a kit to fit a club length to a player since Novosel or Flood or Yim have rounded soles for heads and Novosel or Flood or Yim require a club length.

16. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 1 May 2006


STEPHEN BLAU
PRIMARY EXAMINER